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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,292	05/03/2000	ULRICH KLAR	SCH1742	1743

7590 10/17/2005

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EXAMINER
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CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/485,292	KLAR ET AL.	
	Examiner	Art Unit	
	Celia Chang	1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,6,8-12,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-6, 8-12, 31-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*Handwritten mark*

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### DETAILED ACTION

1. This application is a RCE of SN 09/485,292. The after final amendment filed by applicants dated July 8, 2005 have been entered per applicants' request.

Claims 3, 4, 7, 13-30 have been canceled. Claims 1-2, 5-6, 8-12, 31-32 are pending.

2. Claims 1-2, 5-6, 9-12, 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention; or which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is noted in the specification that, on page 4, the "X" moiety was defined to be optionally a group  $CR^{10}R^{11}$ , wherein  $R^{10}$  or  $R^{11}$  can be hydrogen, C1-20 alkyl, aryl etc. and the aryl moieties were exemplified on page 8. No definition was found for the instantly claimed scope that "one of  $R^{10}$  and  $R^{11}$  is H, and the other is 2-methyl-4-thiazolyl" (to the extent that the scope of claim 1 encompassed this term) which lacks antecedent basis from the specification. Generically, no description can be found that X,  $R^{10}$  or  $R^{11}$  was 2-methyl-4-thiazolyl. The new specific limitation of the claimed scope lacks description, thus, how to make and/or use from the specification. Ex parte Grasselli 231 USPQ 393. Please note that species of compounds containing 2-methyl-4-thiazolyl moiety were exemplified. Such disclosure while provide antecedent basis and description of the species, does not support any generic description or enablement as it has been delineated supra. The claims as now amended, thus, are "different" from the generic concept as originally disclosed. This is a New Matter rejection. Removal of new matter is required. In re Rasmussen 211 USPQ 323.

3. Claims 1-2, 5-6, 8-12, 31-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over allowed claims 1-5, 17-18, 20-21, 23-33 of SN 09/913,163 or claim 3 or SN 10/631,011. Although the conflicting claims are not identical, they are not patentably distinct from each other because the allowed claims are drawn

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to the instant claims when R8 is methyl and R2a/R2b are not simultaneously H/methyl compounds, thus, fully embraced by the instant claims.

Claims 1-2, 5-6, 8-12, 31-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over allowed claims 1-5, 17-18, 20-21, 23-33 of SN 09/913,163 or claim 3 or SN 10/631,011 in view of claims 1-56 of US 6,610,736.

The instant claims are broader than the issued claims 1-5, 17-18, 20-21, 23-33 of SN 09/913,163. The broad scope differs from the allowed scope in that when R8 is not hydrogen, the D-E bonding and R1a, R1b, R2a, R2b are also broadened in scope. The broadened scope of the Markush elements are recognized by the claims in the issued patent US 6,610,736 as alternative choices for such Markush elements. The modification of a more limited scope by the art recognized alternative proven operable equivalencies of the identical Markush elements is considered *prima facie* obvious. No evidence in the record provided any reason why the conventional alternative equivalencies would not be reasonable modification well documented in the art.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-6, 9-12 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 132:293587 and Nicolaou et al.

The rational for finding the instant claims prima facie obvious was clearly delineated in the office action dated Mar 4, 2004 which will not be repeated but is incorporated by reference.

The submission of a declaration under 37 CFR 1.132 showing unexpected properties for R8 is methyl when one of R10 or R11 is 2-methyl-4-thiazolyl or 2-pyridyl, one of R2a or R2b is H, the other is ethyl, cannot support the instant scope which is not commensurate with the unexpected results of the declaration.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*OACS/Chang*  
*Oct. 12, 2005*

  
*Celia Chang*  
*Primary Examiner*  
*Art Unit 1625*